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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/051,873 | 01/17/2002 | Tom Davisson | 152/62692-RDK | 7903 |

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05/21/2004

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| EXAMINER |
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MORILLO, JANELLE COMBS

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| ART UNIT | PAPER NUMBER |
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1742

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/051,873

Applicant(s)

DAVISSON ET AL.

Examiner

Janelle Combs-Morillo

Art Unit

1742

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 102(b) rejection over Toma.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-11,21-23.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


10/054,873

Continuation of 5. does NOT place the application in condition for allowance because: applicant has shown that Zr (in ranges taught by the examples of Toma that fall within the instant ranges, see Table 1) does materially effect the instant alloy product, and therefore the 102(b) rejection over Toma has been overcome. However, the 103(a) rejections over Toma or Sircar have not been overcome.

Firstly, applicant has not shown that the minimum range taught by Toma of 0.02% Zr or the minimum range of Ti taught by Sircar of 0.03% Ti materially effects the instant alloy product.

Secondly, though Toma teaches that the presence of Zr improves high temperature sag resistance, the examiner submits that it would have been obvious to one of ordinary skill in the art to remove Zr from the Al alloy of Toma, along with its intended purpose of improved high temperature sag resistance. Similarly, that it would have been obvious to one of ordinary skill in the art to remove Ti from the Al alloy of Sircar, along with its intended purpose. The examiner notes that the omission of an element and retention of its function is an indicia of unobviousness. In re Edge, 359 F.2d 896, 149 USPQ 556 (CCPA 1966) (MPEP 2144-04). However, though applicant argues that the presence of Zr decreases sag resistance (see 1.132 declaration filed 4/22/04, items 6-10) applicant has not shown specific unexpected results supporting this conclusion.

It is unclear the degree of "sag resistance" exhibited by the instant invention, compared to the prior art. Toma teaches an alloy composition substantially identical to the instant composition, however with added Zr in order to improve high temperature sag resistance (wherein Toma teaches examples to show this effect, see Tables 1 and 2). Applicant argues the elimination of grain refiners, such as Zr, along with continuous casting in order to maintain Mn in solution (see Declaration item 7) leads to a larger grain size and improved sag resistance. However, applicant has not provided conclusive results supporting this, and arguments of counsel cannot take the place of evidence in the record. MPEP 716.02(g), In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Therefore, the 103 rejections over the prior art of Toma or Sircar are held to be proper.


GEORGE W. HIERSKI
PRIMARY EXAMINER

